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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,131	07/08/2003	Tatsuo Nishizawa	0038-0415P	6009

2292 7590 12/27/2005

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EXAMINER

LE, MICHAEL

ART UNIT	PAPER NUMBER
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2163

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/614,131	Applicant(s) NISHIZAWA, TATSUO	
	Examiner Michael Le	Art Unit 2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

Applicant's claim of foreign priority to Japanese Application No. 2002-198507 filed July 8, 2002 is acknowledged. Receipt of certified copies of the foreign priority documents is also acknowledged. Consequently, claims 1-4 have been examined with a priority date of July 8, 2002.

Applicant is requested to amend the Specification by inserting the claim to foreign priority as the first paragraph of the specification before the Background of the Invention.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: In figure 5, reference character S300. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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2. The drawings are objected to because figure 6 seems to be a screenshot, which is of insufficient quality to be reproduced repeatedly due to the shading of the image. Applicant is requested to redraw the image using a type of drafting software. See MPEP 35 CFR 1.84 for more information regarding the standards for drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because of the use of legal language in lines 7 and 8 with the recitation of "searching means" and "playback means" respectively. Correction is required. See MPEP § 608.01(b).

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: A System for Accessing and Purchasing Digital Audio Books over a Network.

6. The disclosure is objected to because of grammatical and idiomatic informalities. The following are some examples and are by no means the only informalities in the Specification.

7. On page 1, lines 6 and 12, "in" has to be changed to --on--.

8. On page 1, line 16, "mails" has to be changed to --mail--.

9. On page 2, line 2, "higher" has to be changed to --faster--.

10. On page 2, line 27, "accesses" has to be changed to --access--.

11. On page 3, line 2, "accesses" has to be changed to --access--.

12. On page 3, line 26, "interval" has to be changed to --intervals--.

13. On page 4, line 24, "equipments" has to be changed too --equipment--.

14. On page 4, line 26, "Firstly" has to be changed to --First--.

15. On page 7, lines 16-18, the sentence is grammatically awkward.

16. Applicant's cooperation is requesting to review the Specification in its entirety to correct any additional grammatical or idiomatic informalities as appropriate.

Claim Objections

17. **Claims 2 and 4 are objected to** because of the following informalities:
18. **Claim 2** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. As written, claim 2 seems to only repeat the limitation of claim 1, lines 14-16.
19. In **claim 4**, lines 6, “interval” has to be changed to --intervals--.
- Appropriate correction is required.

Claim Rejections - 35 USC § 102

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

21. **Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Hay et al. (US Patent Pub 2002/0184189) hereinafter “Hay”.**

22. In regards to **claim 1**, Hay discloses a system for deliver digital books comprising:
- a. a plurality of content servers being connected to a network (Fig. 1B), said content servers storing digital audio data of digital books, which can be played back as voice (para. 0013; para. 0180, lines 8-12; para. 0185, lines 1-16);

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b. a data base server being connected to the network (Fig. 1B), said data base server having a book data base storing search data of the digital books, which include addresses of the digital books in said content servers and which can be searched on the basis of book information including names of authors and titles (para. 0113, lines 4-5, 20-23, 27-31); and

c. a terminal equipment being connected to the network (Fig. 1B), said terminal equipment including:

i. searching means for searching the search data of an object digital book on the basis of the book information thereof (para. 0113, lines 4-5, 20-23; para. 0185, lines 1-16); and

ii. playback means for communicating with the contents servers including the digital audio data of the object digital book on the basis of the search data searched by said searching means (para. 0113, lines 4-5, 20-23), downloading the digital audio data of the object digital book from the contents server and playing back the digital audio data as voice (para. 0113, lines 36-40; para. 0180, lines 8-12; para. 0185, lines 1-16; para. 0190, lines 4-6).

23. **Claim 2** is rejected since the limitation was addressed above in the rejection to claim 1, limitation c (ii).

24. In regards to **claim 3**, Hay discloses the system according to claim 1, wherein said network is the internet and said searching means is a web browser in a terminal equipment (para. 0185, lines 1-16).

Claim Rejections - 35 USC § 103

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. **Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hay et al. (US Patent Pub 2002/0184189) hereinafter "Hay", in view of Wiser et al. (US Patent 6,385,596) hereinafter "Wiser".**

27. Hay discloses the limitations of parent claim 1 as addressed above. Hay also discloses a database for storing data about the electronic books (Hay: para. 0113, lines 27-31). Hay further discloses digital data storage capable of storing the logs (Hay: Fig. 1B, element 50).

28. Hay does not expressly disclose storing logs in a log database of a database server on predetermined time intervals, wherein the logs contain time of downloading digital audio data of digital books from the content servers and the digital audio data downloaded. Hay does disclose having a library which provides a useful record (log) of all the books that have been installed (downloaded) on the computer (terminal equipment) (Hay: para. 0091, 1-8) and to store other information about the electronic books such as an automatic date and time information of when the user has completed the book (Hay: para. 0093, lines 1-10).

29. Wiser discloses logging purchases of digital audio data and storing the logs in a database (Wiser: col. 18, lines 23-31). Wiser further discloses uploading a log periodically (predetermined time intervals) to a media licensing center (database server) (Col. 18, lines 31-

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33). Wiser further discloses that the logs contain entries of when a media data file is downloaded, timestamps, track title, artist name (author), etc (Wiser: col. 20, lines 35-46).

30. Hay and Wiser are analogous art because they are from the same field of endeavor of remote distribution of digital data.

31. At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the system of Hay by adding storing logs in a log database of a database server on predetermined time intervals, wherein the logs contain time of downloading digital audio data of digital books from the content servers and the digital audio data downloaded, as taught by Wiser.

32. The motivation for doing so would have been because logging enables a merchant to keep track of what media has been sold and allows the merchant to accurately report to a rights agent for copyright notification and billing purposes (Wiser: col. 18, lines 25-28).

Conclusion

33. The following are prior art made of record and not relied upon but is considered pertinent to applicant's disclosure.

34. Ireton (US Patent Pub 2002/0077984) discloses a system for protected digital media sharing between playback devices over a network. Williams (US Patent Pub 2002/0002541) discloses an online digital content library that allows users to download the content over the network. Katz et al. (US Patent 6,560,651) discloses a digital information library and delivery system wherein the client includes a playback device. Wittkotter (US Patent Pub 2003/0195854) discloses a method for distribution of electronic documents.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Le whose telephone number is 571-272-7970. The examiner can normally be reached on Mon-Thurs : 9:30am-6pm, Fri: 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



UYEN LE
PRIMARY EXAMINER

Michael Le
Art Unit 2163
December 21, 2005